

REMARKS

I. 35 U.S.C. § 103(a)

In the Office Action, the Examiner has rejected Claims 1-7, 9-10, and 17-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Su, U.S. Publication 2002/0026380, in view of Cohen et al., U.S. Patent 6,505,171, and further in view of Weiss, U.S. Patent 6,511,377.

Applicant respectfully disagrees with the Examiner's conclusion. Applicant claims:

A system for secure and private on-line shopping comprising, in combination:

a store housing a plurality of computers, the store functioning as an on-line shopping store where individuals can order merchandise and have the merchandise delivered to the store for pick-up, one can enter a delivery location for the merchandise on one of the plurality of computers if delivery is not to the store;

an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site;

at least one home computer coupled to the on-line shopping store server for accessing on-line retailers from a remote location;

an on-line store shopping card for purchasing items from on-line retailers by individuals using the plurality of computers at the store and remotely at the at least one home computer, wherein the on-line store shopping card is a pre-paid card having an assigned monetary value, individuals using the on-line store shopping card being able to return the on-line store shopping card for cash on unused credit after shopping at the store; and

an on-line shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and

from a user of the on-line store shopping card and the on-line retailers.

In Applicant's claimed invention, Applicants provide an on-line store shopping card for purchasing items from on-line retailers by individuals using the plurality of computers at the store and remotely at the at least one home computer. The on-line store shopping card is a pre-paid card having an assigned monetary value where individuals using the on-line store shopping card are able to return the on-line store shopping card for cash on unused credit after shopping at the store.

The Examiner acknowledges that Su fails to disclose the on-line shopping card. However, the Examiner claims that Cohen discloses the use of the on-line shopping card. Applicant respectfully disagrees. The on-line shopping card used in Cohen is 3rd party card. The 3rd party cards are processed by a third party administrator. In contrast, the on-line store shopping card used in Applicant's invention is provided by the on-line store and not a 3rd party. The on-line store shopping card is processed by the on-line store card server and not a third party server.

To further differentiate Applicant's claimed invention from the cited prior art, Applicant's on-line store shopping card is a pre-paid card having an assigned monetary value. Individuals using the on-line store shopping card are able to return the on-line store shopping card for cash on unused credit after shopping at the

store. Thus, individuals shopping from a remote location can return the on-line store shopping card for credit. The Examiner acknowledges that neither Su nor Cohen disclose the above. However, the Examiner contends that Weiss discloses a playing card which a player may take to a redemption apparatus and redeem the balance from his account. However, as stated above, Applicant's on-line store shopping card can be used by individuals at the on-line store or at a remote location. The on-line store shopping card can be redeemed for unused credit by a person at the on-line store or by the person shopping remotely. In contrast, in the Weiss patent, in order to redeem a party's balance a player must take his/her card to the redemption apparatus to redeem any balances for cash and perquisite vouchers directly from the redemption apparatus. The redemption apparatus is a free standing super structure which is presented to the player on the casino floor. Nowhere is it disclosed or anticipated that a person from a remote location can return the on-line store shopping card for cash on unused credit.

Furthermore, the legal standard for obviousness under 35 U.S.C. 103 has been the subject of much analysis. The Federal Circuit has enunciated several guidelines in making a Sec. 103 obviousness determination.

A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.

In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051 (C.C.P.A. 1976)).

{T}he examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. "{The Examiner} can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (Emphasis added)

In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984) and In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1988))).

For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art itself or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

Perhaps the Examiner somehow believes that one of ordinary skill in the art could conceivably combine the cited references to produce Applicants' claimed invention. But the Federal Circuit has held that

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. (Emphasis added)
In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (citations omitted).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Emphasis added) But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." (Emphasis added)

In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988) (citing In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q.871, 881 (C.C.P.A. 1981) and ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Lindemann, Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984)).

Applicant respectfully yet strenuously contends that the Examiner has shown no teaching nor suggestion in any one of the cited references or elsewhere of Applicant's claimed apparatus to support a conclusion of obviousness.

Applicant respectfully submit that the Examiner has fallen into the common trap of hindsight reconstruction, which has been frequently denounced by the Federal Circuit as inappropriate to support a finding of obviousness.

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decisionmaker to return to the time the invention was made. "the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988) (quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (Fed. Cir. 1985)).

It is clear from the Examiner's rejection that, absent the "blueprint" of Applicants' disclosure, the prior art has no

suggestion or teaching of Applicants' claimed invention. The Federal Circuit has also stated:

It is improper to use the patent as an instruction manual to lead to elements of the prior art.
Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987).

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.
In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885, 188 (Fed. Cir. 1991)).

It is very clear from the Examiner's language that Applicants' claimed invention is only rendered invalid for obviousness if the Applicants' claimed invention is used as an instruction manual, or template, for modifying the cited prior art. Absent the knowledge gleaned from Applicants' disclosure, there is no suggestion or teaching in the cited prior art or in the general knowledge in the art to support the Examiner's assertion that Applicants' claimed invention would have been obviousness to one of ordinary skill in the art. The Federal Circuit has also stated:

When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.
Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985)).

The Examiner has cited no reason for modifying the cited references to allegedly achieve Applicants' claimed invention other

than the knowledge gleaned from Applicants' disclosure. For this reason the Examiner has failed to establish a prima facie case of obviousness based on a combination of these specific references.

For the above reasons, Applicant respectfully submits that the above arguments effectively traverse the Examiner's rejection of the claim under 35 U.S.C. § 103(a). Such action is earnestly solicited.

II. Conclusion

Applicant respectfully submit that Applicant's claimed invention is deserving of patent protection because it describes a useful and functioning apparatus which is patentably distinguishable over the prior art.

In conclusion, Applicant respectfully submits that this Amendment Letter, including the amendments to the Claims, and in view of the Remarks offered in conjunction therewith, are fully responsive to all aspects of the objections and rejections tendered by the Examiner in the Office Action. Applicant respectfully submits that he has persuasively demonstrated that the above-identified Patent Application, including Claims 1, 3-10, 17-20, and 22-23 are in condition for allowance. Such action is earnestly solicited.

If the foregoing does not place the case in condition for immediate allowance, the Examiner is respectfully requested to contact the undersigned for purposes of a telephone interview. I

there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 23-0830.

Respectfully submitted,



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